

122 - # 130.00

PATENT
57111-50617/045

for
Petru
3/18/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

VOTRUBA, et al.

Serial No. 09/884,706

Filed: June 19, 2001

For: DOOR LATCHING
SYSTEM

Group Art Unit: 3627

Examiner: Not yet assigned

CERTIFICATE OF MAILING

I hereby certify that this correspondence and the identified enclosures are being deposited with the U.S. Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, Attn: Licensing and Review on June 6, 2002 by *Michelle Daugherty*

Assistant Commissioner for Patents
Washington D.C. 20231
Attention: Licensing and Review

PETITION FOR RETROACTIVE LICENSE UNDER 37 CFR § 5.25

Dear Sir:

Applicant respectfully petitions the Commissioner for a foreign filing license for the above-captioned pending application retroactive to July 27, 2001.

The pending U.S. application was filed on June 19, 2001 and a foreign filing license was granted on August 11, 2001. The application was filed in the following foreign country: Canada. The application was filed in Canada on July 27, 2001.

Attached hereto are a Declaration of Rupak Nag and a Declaration of Brennan C. Swain.

Our Check No. 148987 in the amount of \$130.00 is enclosed for payment of the required fee. The Commissioner is authorized to charge any additional amounts due in connection with

06/14/2002 DBATES 00000004 09844706
this matter to our Deposit Account No. 10-0440. A duplicate copy of this letter is enclosed.
01 FC:122 130.00 DP

09/844706

Serial No. 09/884,706

It is respectfully requested that this petition for retroactive license be granted under 35 U.S.C. § 184.

Respectfully submitted,

June 3, 2002
Date

Rupak Mag
RUPAK MAG
Reg. No. 37,493

JEFFER, MANGELS, BUTLER & MARMARO LLP
Tenth Floor
2121 Avenue of the Stars
Los Angeles, CA 90067
Tel: (310) 203-8080

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

VOTRUBA, et al.

Serial No. 09/884,706

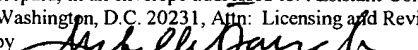
Filed: June 19, 2001

For: DOOR LATCHING
SYSTEM

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Assistant Commissioner for Patents
Washington D.C. 20231
Attention: Licensing and Review

**DECLARATION OF RUPAK NAG IN SUPPORT OF
PETITION FOR RETROACTIVE LICENSE (37 CFR 5.25)**

I, Rupak Nag, declare the following of my own personal knowledge:

1. On May 10, 2002, I learned from a colleague of a complaint filed in an unrelated matter which raised issues regarding foreign filing licenses and the filing of patent applications abroad. This triggered my colleague to instruct me to review all patent applications of our firm to confirm that appropriate foreign filing licenses had been obtained before filing abroad.


2. I thereupon initiated an investigation to ensure that patent applications filed abroad were filed after the applicant had been granted a foreign filing license.

3. The investigation involved checking many applications and revealed that the above-referenced application was filed in Canada before a foreign filing license was granted.

4. I immediately proceeded to investigate the requirements of obtaining a retroactive foreign filing license. On or about May 22, 2002, I obtained copies of transmittal letters and other documents required by 37 C.F.R. § 5.25 to support facts showing that the Canadian filing was through error and without deceptive intent. Upon conducting this investigation, I learned that Brennan C. Swain, an attorney formerly with Jeffer Mangels Butler & Marmaro, LLP, had personal knowledge of the events leading to the proscribed filing in Canada. Upon contacting him, a declaration by Brennan C. Swain attesting to facts leading to the proscribed filing and documents in support thereof was prepared and executed by Mr. Swain, and accompanies the attached petition for retroactive license.

I declare under penalty of perjury that the foregoing is true and correct.

Executed this 5 day of June, 2002, in Los Angeles, California, U.S.A.



RUPAK NAG, Reg. No. 37,493

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| SERIAL NUMBER | REQUEST DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
|---------------|--------------|-----------------------|---------------------|
| 09/884,706 | 6/13/02 | VOTRUBA, ET AL | 57111-5061/7045 |

Title: DOOR LATCHING SYSTEM

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|----------|--------------|
| Art Unit | Paper Number |
|----------|--------------|

Correspondence Address:

RUPAK NAG
JEEFER, MANGELS, BUTLER & MARMARO LLP
ATTORNEYS AT LAW TENTH FLOOR 2121 AVENUE OF THE
STARS
LOS ANGELES CA 90067

PATENT & TRADEMARK OFFICE
MAILED

MAR 18 2003

LICENSING & REVIEW

Licensee under 35 U.S.C. 184 is hereby granted to file in any foreign country a patent application and any amendments thereto corresponding to the subject matter of this U.S. application identified above and/or any material accompanying the petition. This license is conditioned upon modification of any applicable secrecy order and is subject to revocation without notice.

License Number: 530,268
Grant Date: 18-Mar-03

This license is granted retroactively to the date(s) and the country(s) indicated on the attached decision.

Approved:

for Commissioner of Patents and Trademarks

This license empowers the filing, the causation and the authorization of the filing of a foreign application or applications on the subject matter identified above, subsequent forwarding of all duplicate and formal papers and the prosecution of such application or applications.

This license is granted under 37 CFR 5.15(a)

This license is to be retained by the licensee and may be used at anytime on or after the date thereof.
This license is not retroactive unless specifically indicated.

The grant of this license does not in any way lessen the responsibility of the licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations, especially with respect to certain countries, of other agencies, particularly the Department of the Treasury; Office of Munitions Control, Department of State (with respect to Arms, Munitions and Implements of War); the Bureau of Trade Regulation, Office of Export Administration, Department of Commerce; and the Department of Energy.

LICENSE FOR FOREIGN FILING

[Title 35, United States Code (1952) Sections 184, 185, 186]



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

Brennan C. Swain
JEFFER, MANGELS, BUTLER & MARMARO LLP
Tenth Floor
2121 Avenue of the Stars
Los Angeles, CA 90067

In re: VOTRUBA et al : DECISION ON REQUEST
Serial No.: 09/884,706 : UNDER 37 CFR 5.25
Filing date: 19 June 2001
Docket No: 57111 5061/70

Title: DOOR LATCHING SYSTEM

In view of the communication(s) filed 12 February 2003, it has been determined that a retroactive license for foreign filing under 35 U.S.C. 184 be granted with respect to the filings listed below. The petition complies with 37 C.F.R. 5.25 in that there is an adequate showing that the subject matter in question was not under secrecy order, that the license was diligently sought after discovery of the proscribed foreign filing, and that the material was filed abroad without the required license under 37 C.F.R. 5.11 first having been obtained through error and without deceptive intent.

| <u>Country</u> | <u>Date</u> |
|----------------|--------------|
| Canada | 27 July 2001 |

Approved:

Andrea M. Valenti
Andrea M. Valenti
Patent Examiner
Group 3643
(703) 305-3010

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

VOTRUBA, et al.

Serial No. 09/884,706

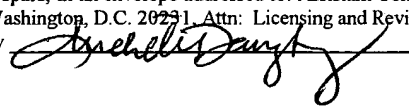
Filed: June 19, 2001

For: DOOR LATCHING
SYSTEM

Group Art Unit: 3627

Examiner: K. Patel

CERTIFICATE OF MAILING

I hereby certify that this correspondence and the identified enclosures are being deposited with the U.S. Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, Attn: Licensing and Review on June 6, 2002 by 

Assistant Commissioner for Patents
Washington D.C. 20231
Attention: Licensing and Review

**DECLARATION OF BRENNAN C. SWAIN IN SUPPORT OF
PETITION FOR RETROACTIVE LICENSE (37 CFR 5.25)**

I, Brennan C. Swain, declare the following of my own personal knowledge:

1. U-Haul International, Inc., assignee in the above-referenced matter, has standing instructions with the law firm of Jeffer, Mangels, Butler & Marmaro, LLP to file patent applications in Canada corresponding to each patent application filed in the United States, unless specifically instructed otherwise.

2. On June 26, 2001, I sent a letter to Omar A. Nassif, Esq. of Gowling Lafleur Henderson, a law firm in Toronto, Canada, instructing him to prepare the necessary papers and file a patent application in Canada corresponding to a U.S. application filed on June 19, 2001. A copy of the letter is attached as Exhibit A.

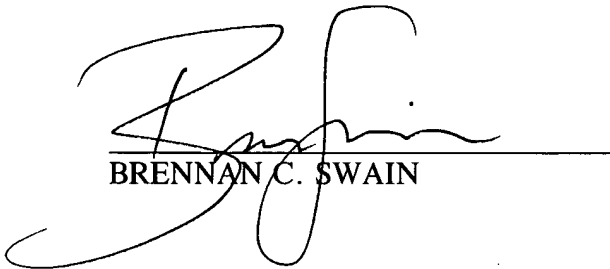
3. On August 7, 2001 I received a letter dated August 1, 2001 from Mr. Nassif informing us that the patent application had been filed with the Canadian Patent Office on July 27, 2001. A copy of the letter is attached as Exhibit B.

4. The application was filed in Canada as a result of an oversight in first checking whether a foreign filing license had been granted. This foreign filing license check is normally made when the Official Filing Receipt is received. In this case, I had not yet received an Official Filing Receipt indicating whether a foreign filing license was granted when I instructed Mr. Nassif to file the application in Canada. This oversight was made through error and without deceptive intent.

5. The subject matter of the U.S. patent application was not under a secrecy order at the time it was filed in Canada on July 27, 2001, and is not presently under a secrecy order.

I declare under penalty of perjury that the foregoing is true and correct.

Executed this 30 day of May, 2002, in Los Angeles, California, U.S.A.



BRENNAN C. SWAIN

JEFFER, MANGELS, BUTLER & MARMARO LLP

A LIMITED LIABILITY PARTNERSHIP INCLUDING PROFESSIONAL CORPORATIONS

ATTORNEYS AT LAW

TENTH FLOOR

2121 AVENUE OF THE STARS

LOS ANGELES, CALIFORNIA 90067-5010

(310) 203-8080

INTERNET
BCS@JMBM.COM

BRENNAN C. SWAIN

Member of California and New York Bars

DIRECT DIAL (310) 785-5308

FACSIMILE (310) 785-5318

(310) 203-0567

SAN FRANCISCO OFFICE
TWELFTH FLOOR
ONE SANSOME STREET
SAN FRANCISCO, CALIFORNIA 94104-4405
TELEPHONE (415) 398 8080
FACSIMILE (415) 398-5583

REF /FILE NO

June 26, 2001

57111-7045

ATTORNEY/CLIENT PRIVILEGE - CONFIDENTIALVia Federal ExpressOmar A. Nassif, Esq.
Gowlings, Strathy & Henderson
Commerce Court West, Suite 4900
Toronto, Ontario, Canada M5L 1J3Acknowledged
78466 5230A
RECEIVED
JUN 29 2001GOWLING STRATHY & HENDERSON LLP
PATENT DEPARTMENT

Re: New Canadian Patent Application
 Entitled: "DOOR LATCHING SYSTEM"
 Inventors: Edward J. VOTRUBA; Patrick W. BRESLIN; Michael
 H. DILGARD; David L. SIMPSON and Thomas F.
 BONE
 Applicant: U-Haul International, Inc.
 Priority: U.S. Serial No. [unknown] Filed June 19, 2001
 Our File No.: 57111-7045

Dear Mr. Nassif:

Please proceed accordingly with the preparation and filing of a Canadian patent application based on the above-referenced U.S. patent application. Enclosed are copies of the following documents:

1. Copy of Specification, Claims, abstract and drawings as filed with the U.S. Patent and Trademark Office on June 19, 2000.
2. Copy of the executed Declaration of the inventors which contains their residential addresses.
4. Copy of executed Assignment and executed Power of Attorney by Assignee and Exclusion of Inventor.

A copy of the official filing receipt for the U.S. application will be forwarded to you immediately upon receipt.

CALENDARED

LADOC52699553 1

JUL 2 2001

Jeffer, Mangels, Butler & Marmaro LLP

By AM

EXHIBIT "A"

GOWLINGS

August 1, 2001

Jeffer, Mangels, Butler & Marmaro LLP
Attorneys at Law
Tenth floor
2121 Avenue of the Stars
Los Angeles California 90067-5010
U.S.A.

RECEIVED**AUG 7 2001**

JEFFER, MANGELS, BUTLER & MARMARO LLP

Suite 4900
Commerce Court West
Toronto, Ontario
Canada M5L 1J3
Telephone (416) 862-7525
Facsimile (416) 862-7661
www.gowlings.com

Attention: Brennan C. Swain

Dear Mr. Swain:

Re: New Canadian Patent Application
Applicant: U-HAUL INTERNATIONAL, INC.
Title: **DOOR LATCHING SYSTEM**
Our File: T8-466523CA
Your Ref: 57111-7045

We are pleased to confirm that the above-identified application was filed in the Canadian Patent Office on July 27, 2001. We enclose two copies of our communication to the Canadian Patent Office. We will advise you of the serial number allotted thereto in due course.

Maintenance Fees are due and must be paid annually from **July 27, 2003**. A Request for Examination is due and must be filed at any time prior to **July 27, 2006**.

Our account covering our services and disbursements in this matter will follow under separate cover.

Thank you for entrusting this case to the care of our office. Please do not hesitate to contact us should you require additional assistance in this matter.

Yours very truly,

GOWLING LAFLEUR HENDERSON LLP

Omar A. Nassif

OAN:jpr:Encls.

EXHIBIT "B"

Montreal

Ottawa

Toronto

Hamilton

Waterloo Region

Calgary

CALENDARED
Maint Fee / Exam Docketed
IP297510-1
AUG 7 2001
Jeffer, Mangels, Butler & Marmaro LLP
By ON Vancouver Moscow

GOWLINGS

Suite 4900
Commerce Court West
Toronto, Ontario
Canada M5L 1J3
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Facsimile (416) 862-7661
www.gowlings.com

Omar A. Nassif
Direct (416) 862-5775
omar.nassif@gowlings.com

Assistant: Gail Smith
Direct (416) 862-5435

July 27, 2001

The Commissioner of Patents
Canadian Intellectual Property Office
Ottawa-Hull
K1A 0C9

Dear Sir:

**Re: New Canadian Patent Application For
DOOR LATCHING SYSTEM**
Applicant: U-HAUL INTERNATIONAL, INC.
Our Ref: T8466523CA

We enclose the following documents in connection with the above new Patent application.

| | | |
|-----------------|---|-------------------------|
| Petition | - | One copy |
| Abstract | - | One Copy |
| Specification | - | One Copy (12 pages) |
| Claims | - | One Copy (42 in number) |
| Drawings | - | Formal (Figures 1 to 8) |
| Filing Fee | - | \$300.00 |
| *Assignment Fee | - | 100.00 |
| TOTAL | - | \$400.00 |

*Please note that the correct spelling of the second inventor's name is BRESLIN, Patrick W.

Respectfully submitted,



GOWLING LAFLEUR HENDERSON LLP
(Agents for the Applicant)

OAN:ges
Encl.

INTELLECTUAL_PROP\296795_1
July 27, 2001

FORM 3
Subsection 27(2) of the Patent Act)
Petition for Grant of a Patent

1. The applicant, **U-HAUL INTERNATIONAL, INC.**, whose complete address is **2727 North Central Avenue, Phoenix, Arizona 85036, U.S.A.**, requests the grant of a patent for an invention, entitled

DOOR LATCHING SYSTEM

which is described in the accompanying specification.

2. This application is a division of application number____, filed in Canada on ____ ,

3. (1)
(2) The inventors are:

VOTRUBA, Edward J.
BRESLIN, Patrick W.
DILGARD, Michael H.
SIMPSON, David L.
BONE, Thomas F.,

whose complete addresses are:

526 N. Valencia Place, Chandler, AZ 86226, U.S.A.
11210 N. 67th Drive, Peoria, AZ 85345, U.S.A.
2849 S. Kenwood, Tempe, AZ 85282, U.S.A.
4139 E. Redfield Road, Higley, AZ 86236, U.S.A.
316 E. 7th Drive, Mesa, AZ 85210, U.S.A.

and the applicant owns in Canada the whole interest in the invention.

4. The applicant requests priority in respect of application on the basis of the following previously regularly filed application.

| | | |
|--------------------------|------------------------|----------------------|
| Country of filing | Application No. | Filing Date |
| United States | 09/884,706 | June 19, 2001 |

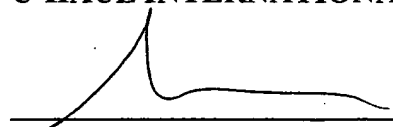
5. The applicant appoints **GOWLING LAFLEUR HENDERSON LLP**, whose complete address in Canada is **Commerce Court West, Suite 4900, Toronto, Ontario, Canada, M5L 1J3** as the applicant's representative in Canada, pursuant to section 29 of the Patent Act.

6. The applicant appoints **GOWLING LAFLEUR HENDERSON LLP**, whose complete address is **Commerce Court West, Suite 4900, Toronto, Ontario, Canada M5L 1J3**, as the applicant's patent agent.

7.

8. The applicant requests that Figure No. 1 of the drawings accompany the abstract when it is open to the public inspection under section 10 of the Patent Act or published.

U-HAUL INTERNATIONAL, INC.



GOWLING LAFLEUR HENDERSON LLP
(Agents for the Applicant)

IP295731_1

UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS

Washington, D.C. 20231

| SERIAL NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
|---------------|-------------|-----------------------|---------------------|
| 09/884,706 | 13-Jun-02 | VOTRUBA, ET AL | 57111-5061/7045 |

Title: DOOR LATCHING SYSTEM

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| Art Unit | Paper Number |
|----------|--------------|

Correspondence Address:

RUPAK NAG

JEEFER, MANGELS, BUTLER & MARMARO LLP

ATTORNEYS AT LAW TENTH FLOOR 2121 AVENUE OF THE STAR

LOS ANGELES CA 90067

PATENT & TRADEMARK OFFICE
MAILED

DEC 24 2002

LICENSING & REVIEW

Please find attached a communication from the Examiner regarding the
Petition for Retroactive License under 37 CFR 5.25.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

Rupak Nag
JEFFER, MANGELS, BUTLER & MARMARO LLP
Tenth Floor
2121 Avenue of the Stars
Los Angeles, CA 90067

In re: VOTRUBA et al : DECISION ON REQUEST
Serial No.: 09/884,706 : UNDER 37 CFR 5.25
Filing date: 19 June 2001
Docket No: 57111 5061/70

Title: DOOR LATCHING SYSTEM

This is a decision on the petition filed on 13 June 2002 for a retroactive foreign filing license. At the time of the filing, the declaration of Brennan C. Swain states that the application was first obtained through error without deceptive intent.

37 CFR 5.25(a) requires the following:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed,
2. The dates on which the material was filed in each country,
3. A verified statement (oath or declaration) containing:
 - i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,
 - ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and
 - iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and
4. The required fee (§ 1.17(h)).

The petition is **Denied** at this time in that the petition is defective since the requirements set forth in 37 C.F.R. 5.25(a)(3)(iii) have not been met.

The declaration of Brennan C. Swain states that the application was filed in Canada on July 27, 2001. However, a copy of the submitted Canadian application must be provided with the petition in order for the record to be complete.

Accordingly, the provisions of 37 CFR 5.25 not having been fully met, the petition is denied, and in the absence of any response within **60 days** of the mailing date of this letter, such denial will

be made final and the final action under 35 U.S.C. 185 will be taken. Extensions of time may be had under 37 C.F.R. 1.136(a).

Andrea M. Valenti

Andrea M. Valenti
Patent Examiner
Group 3643
(703) 305-3010